

251 North Avenue West, 2nd Floor
Westfield, New Jersey 07090
Tel.: (908) 518-7700
Fax: (908) 518-7795

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To: Examiner Thomas Sweet
Group Art Unit 3738

From: Marjorie Scariati

Fax: 571-273-8300

Pages: 11

Phone: 571-272-4761

Date: 04/26/2007

Re: 10/789,398

CC:

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Please see the attached Communication in Response to Requirement for Information Under
37 CFR 1.105 And Petition For An Extension of Time

Serial No. 10/789,398
Examiner Thomas Sweet

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Kathleen M. Miller

Serial No.: 10/789,398

Filed: 02/27/2004

TITLE: IMPLANTABLE OR INSERTABLE MEDICAL DEVICE RESISTANT
TO MICROBIAL GROWTH AND BIOFILM FORMATION

Art Unit: 3738

Examiner: Thomas Sweet

Confirmation No.: 4925

Docket No.: 98-P0151US2

VIA FACSIMILE 571-273-8300

Mail Stop Amendment

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

**COMMUNICATION IN RESPONSE TO REQUIREMENT FOR INFORMATION
UNDER 37 C.F.R. 1.105 AND PETITION FOR AN EXTENSION OF TIME**

Sir:

This is a response to the Requirement for Information mailed on January 26, 2007. A reply to the Requirement is due on March 26, 2007 and thus is being timely filed. Applicant hereby requests a one-month extension of time. Thus, a reply is due on April 26, 2007 and is being timely filed.

Please kindly consider the following remarks.

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REMARKS

In the Requirement for Information, the Examiner stated that there appears to be numerous other co-pending applications and issued patents which disclose or claim very similar and/or identical subject matter. The Examiner provided a non-exhaustive list of co-pending applications and patents that the Examiner believes may be related. The Examiner requested that the Applicant disclose all related applications and identify the specific claims of those applications and/or patents which may present double patenting issues with the instant application claims.

In response, Applicant is submitting an Information Disclosure Statement that lists co-pending applications and patents (eight in total) which it believes are related to the instant application. For each such co-pending application or related patent, Applicant has identified the specific claims which, upon information and belief, may present non-statutory obviousness-type double patenting issues with the instant application claims. Upon information and belief, Applicant believes that the co-pending applications and patents cited in the IDS do not pose statutory same-type double patenting issues under 35 U.S.C. 101 with respect to the claims of the instant application

Regarding issued patents, U.S. Pat. Nos. 6,887,270 and 6,921,390, Applicant hereby attaches executed Terminal Disclaimers to disclaim the terminal part of the statutory term of any patent granted, on the instant application which would extend beyond the expiration dates of the full statutory term of prior U.S. Patent Nos. 6,887,270 and 6,921,390.

Regarding the co-pending applications identified above:

U.S.S.N. 11/125,296 (US 2006/0264912);
U.S.S.N. 10/377,131 (US 2003/0224033);
U.S.S.N. 10/209,476 (US 2004/0022824);
U.S.S.N. 11/188,367 (US 2005/0271698);
U.S.S.N. 11/040,864 (US 2005/0161859); and
U.S.S.N. 10/846,706 (US 2005/0255230), Applicant respectfully states that Terminal Disclaimers will be filed if and when the "provisional" non-statutory obviousness-type double patenting rejection in each application is the only rejection remaining in that application. Pursuant to MPEP 804 I B,

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If the "provisional" double patenting rejection in one application is the only rejection remaining in that application, the examiner should then withdraw that rejection and permit the application to issue as a patent, thereby converting the "provisional" double patenting rejection in the other application(s) into a double patenting rejection at the time the one application issues as a patent.

Thus, since the co-pending applications have not issued as patents and the claims may be amended in the future, Applicant respectfully exercises its right to address the provisional rejections at a future date.

Applicant states that it has now fully responded to the Requirement for Information pursuant to 37 C.F.R. 1.105. If the Examiner believes that further information is required or an interview would expedite consideration of the application, the undersigned attorney requests that the Examiner telephone her at the number indicated. The Office is authorized to charge any fees required, to deposit account number 50-1047.

Respectfully submitted,



Keum J. Park
Registration No. 42,059

Attorney for Applicant
Mayer & Williams PC
251 North Avenue West, 2nd Floor
Westfield, NJ 07090
Tel.: 908-518-7700, ext. 7
Fax: 908-518-7795

Certificate of Facsimile Transmission

I hereby certify that this document and any document referenced herein is being sent to the United States Patent and Trademark office via Facsimile to: 571-273-8300 on 4/26/07.

Marjorie Scariati

(Printed Name of Person Mailing Correspondence)

Marjorie Scariati
(Signature)